

REMARKS

In response to the final Office Action dated January 7, 2009, Applicant presents the foregoing amendments and respectfully requests reconsideration. These amendments address the issues raised with respect to claims 30-31, adjust the dependency of claims 32 and 34-35, and cancel claim 33. Claim 9 is also amended to differentiate it from claim 13, but without adding any new matter and without broadening the scope of the claim. Since these changes place the claims in better form for purposes of appeal, entry is proper and respectfully requested.

As to the current anticipation rejection of claim 30 made in the Action based on Nagata et al., Applicants respectfully traverse this rejection for the following reasons. For a proper rejection based on anticipation, the law requires each and every element of the claim to be found within the four corners of the reference. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (holding that an anticipating reference must describe all claimed aspects of the invention). This "strict identity" requirement means that "unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102." *Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359 (Fed. Cir. 2008). The "mere possibility" that the claimed structure exists in the reference is inadequate to meet this "strict identity" requirement. *See Continental Can Company USA v. Monsanto Company*, 948 F.2d 1264, 1269, 20 USPQ2d 1746 (Fed. Cir. 1991) (holding that anticipation "may not be established by probabilities or possibilities").

Applicant acknowledges that Nagata et al. generally states that: “[i]t is particularly preferable to use polyester-based fibers for the first, second and third fibers, in view of being high in melting point (T_m) of crystal, in strength and in modulus and being relatively cheap in price and being stable in commercial availability.” Nonetheless, it does not follow that Nagata et al. discloses within its four corners the exact same invention as claim 30. Indeed, it cannot be disputed that Nagata et al. does not expressly describe crystalline/semi-crystalline high melt bi-component fibers, including the passage cited by the Examiner. Accordingly, a proper rejection based on anticipation has not been established with respect to claim 30.

Applicant further submits that it is not “inherent” in the Nagata et al. reference that the disclosed bicomponent fibers are of the structure claimed. For a rejection to be proper based on “inherency,” the missing claim feature must necessarily be present in the reference. *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282, 54 USPQ2d 1673 (Fed. Cir. 2000) (“a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing feature is *necessarily present*”) (emphasis added). Consequently, the mere probability or possibility that the claimed invention might result under certain circumstances is insufficient. *Continental Can Company USA v. Monsanto Company*, 948 F.2d 1264, 1269, 20 USPQ2d 1746 (Fed. Cir. 1991) (“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”). *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597 (Fed. Cir. 2002). See also *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation “cannot be

predicated on mere conjecture respecting the characteristics of products . . . "); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

In the instant situation, no substantial evidence or convincing line of reasoning explains why it is "necessarily" the case that Nagata et al. discloses the claimed arrangement of fibers, merely because it mentions that "polyester-based" fibers may be "high-melting point . . . in crystal." In the Action, the Examiner asserts that Nagata et al. anticipates the invention of claim 30, stating that "Nagata et al. mentions the high melting point of the crystals in the PET meaning that the fibers must have some level of crystallinity" (Office Action of January 7, 2009, page 5, lines 4-5). Respectfully, Applicant submits this is pure speculation on the part of the Examiner, unsupported by any evidence or convincing line of argument. The statement made in support of the rejection disregards the existence of amorphous (e.g., non-crystalline) fibers, which "maintain a fiber form" despite neither being crystalline or semi-crystalline. Indeed, Applicant notes that each and every example provided in Nagata et al. uses amorphous (that is, not crystalline or semi-crystalline) fibers. *See, e.g.*, col. 7, lines 7 and 10). In light of the above, Applicant respectfully submits that claim 30 in neither anticipated nor obvious in view of Nagata et al.

Turning to the rejections of claims 1, 5-7, 9-19, and 21-26 as obvious over Nagata et al., Applicant again notes that Nagata et al. does not in any way describe, teach, or suggest crystalline/semi-crystalline high melt bi-component fibers comprising CoPET/PET. The Examiner's statements that Nagata et al. "mentions the high melting point of the crystals in the PET" and it therefore follows that "the bicomponent fibers are at least semi-crystalline" finds no support anywhere in the Nagata et al. reference.

Moreover, this statement does not *per se* establish that a skilled artisan would have found it obvious to employ the claimed arrangement of fibers in the manner proposed by the Applicant. Indeed, as previously noted, each and every example provided in Nagata et al. uses amorphous (that is, not crystalline or semi-crystalline) fibers. See, e.g., col. 7, lines 7 and 10.

In light of the above, Applicant submits that independent claims 1 and 30 patentably distinguish over Nagata et al. and are in condition for allowance. Claims 5-7, 9-19, 21-26 and 31-35 depend directly or indirectly from claim 1 or claim 30, and are in condition for allowance for at least those reasons. Reconsideration of the decision to reject these claims is respectfully requested. Any fees required in connection with this Response may be debited to Deposit Account 50-0568.

Respectfully submitted,

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Date 3-05-2009

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